UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,834	09/19/2003	Bjorn Bjare	P17551US2	6032

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EXAMINER
VU, TUAN A

ART UNIT	PAPER NUMBER
2193	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/665,834	BJARE ET AL.
	Examiner	Art Unit	
	Tuan A. Vu	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/07/06*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *4/26/04 (updated copy)*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the Applicant's response filed 12/27/06.

As indicated in Applicant's response, claims 1, 10, 21 have been amended, and claim 22

added. Claims 1-22 are pending in the office action.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection
is appropriate where the conflicting claims are not identical, but at least one examined
application claim is not patentably distinct from the reference claim(s) because the examined
application claim is either anticipated by, or would have been obvious over, the reference
claim(s). See, e.g., *In re Berg,* 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re
Goodman,* 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi,* 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum,* 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re
Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
be used to overcome an actual or provisional rejection based on a nonstatutory double patenting
ground provided the conflicting application or patent either is shown to be commonly owned
with this application, or claims an invention made as a result of activities undertaken within the
scope of a joint research agreement.
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR
3.73(b).

3.   Claims 1, 10 are provisionally rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claim 3 of copending Application No. 10,664,618

(referred herein as '618).

As per instant claims 1 and 10, '618 claim 3 also recites a platform domain with

software application interacting with an interface domain, wherein the software application

entities of the platform domain (i.e. domain having software services components) are adapted to

interact with the interface domain and a plug-in entity; the platform domain having a plug-in

entity (re '618 claim 2) the plug-in entity adapted to extend the functionality of the platform

domain. Claim 3 recites having a utility entity to make use of the interface domain and one or

more of the application entities (or software components) and the reciting of this utility entity to

make use of the application entities in said platform suggests that an software application utility

is there to enable application software platform components to be accessed or run in said

platform via the use of said this combined utility and interface entities. Although '618 claim 3

does not recite enabling software application software to be installed, loaded or run in said

platform, it would have been obvious for one skill in the art to implement that utility entity such

that this utility entity be used to access the software entities, load/install them and run them in the

above platform in view of the combined inter-usage of interface and plug-in entities so to support

the extending of the platform functionality via interfacing with the applications entities (see '618

claims 2-3).

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter.

Claim 1 recites a system with a purport of modifying functionality of on a mobile

terminal platform and communications system, the system having a mobile platform domain

with software services component, an interface component for providing access to software

functionality, for enabling application software to be loaded and run, and a plug-in software.

Mere recital of a domain along with software components without embodiment of such software

(or its functionality) in terms of hardware support or computer readable media amounts to not

having tangible support to carry out or actualize the software functionality. The claim for listing

descriptive functional elements fails to reasonably convey as a whole that the claimed invention

can yield a real-world result; that is, the recited software appear to be merely listed without being

interacted by a hardware support in order to make the invention a practical application, i.e. not

yielding a concrete, tangible and useful result.

> The Federal Circuit has recently applied the practical application test in determining whether the claimed
> subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a " useful,
> concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a
> patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the
> "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a
> concrete, tangible, and useful result. The test for practical application is thus to determine whether the
> claimed invention produces a "useful, concrete and tangible result".

The above claim does not amount to fulfilling the Practical Application Test requirement; and

along with its dependent claims 2-8 is rejected for leading to non-statutory subject matter.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart et al.,

USPubN: 2001/0039570 (hereinafter Stewart).

As per claim 1, Stewart discloses a system for extending and/or modifying functionality

of a platform for a mobile terminal of a wireless telecommunications system (e.g. para 0278, pg.

16), comprising:

a mobile terminal platform domain having a software services component (Web

Application – Fig. 1; Application Services – Fig. 1) for providing functionality, and

an interface component having at least one interface for providing access to the

functionality of the software services component (e.g. Collaboration, Workflow server – Fig .1;

Fig 16; *conversation mgmt, message handling* -Fig. 8) for enabling application domain software

to be installed, loaded and run in said platform via said at least one interface (e.g. Fig. 17; para

0165-0170, pg. 11 – Note: *WebLogic* integration server using workflow server to communicate

with client application via messages – e.g. for deploying networks, suppliers functions - reads on

interface for enabling software to be installed and loaded onto client execution engine); and

plug-in software for use by the application software for extending and/or modifying the

functionality of the software services component (e.g. routing functionality, content modification

- para 0171-0187, pg. 11-12; *tailor the list* – para 0173, pg. 11) of the platform domain via the at

least one interface.

As per claim 2, Stewart discloses wherein said at least one interface comprises an

application programming interface (*interfaces* – para 0011, para 0075, 0078-0080, pg. 6; C-

enabler *API* - para 0251, pg. 14).

As per claims 3-4, Stewart discloses wherein said plug-in software comprises software

residing in a domain of said application software (para 0176, pg. 11 – Note: plug-in reads on

residing inside the application of the partners or users' machine in the chain of the E-commerce

Workflow of the collaborative system – see para 0237, pg. 13, wherein modeling tool from C-space trading partners entails using plug-in to configure message design) and that uses the functionality of at least one of the platform domain and other plug-in software (para 0182, pg. 12);

wherein said plug-in software complies with a same paradigm as provided services (protocol --para 0184 pg. 12; Fig. 16; para 0191-0232 – Note: filtering/redefining of message using Protocol plug-in per partner application within the message-routing scheme reads on compliance of plug-in with *RosettaNet* or *XOCP* protocol) exported by said application programming interface.

As per claims 5-6, Stewart discloses wherein said provided services include one or more of component model compliance (para 0348, pg. 18), naming convention compliance (para 0302, pg. 16), undesired-event handling compliance (Fig. 9; para 0334, pg. 17) and message model compliance (Fig. 6; step 208-210, Fig. 7); wherein said message model includes a callback mode (*Asynchronous Message* - para 0330, pg. 17) and a full message mode (*Synchronous* - para 0328, pg. 17; Fig. 6; *RMI* - para 0170, pg. 11).

As per claims 7-8, Stewart discloses wherein said plug-in software includes a plurality of plug-in software modules (e.g. para 0171, 0174, 0183, pg. 11-12); wherein said plug-in software includes plug-in software defining a set of graphical objects and utilities for defining a look and feel of said platform (*tailor the list* – para 0173, pg. 11; para 0180-0181, pg. 12; *graphical design* - para 0237, pg. 13; *layout ...expanded later* - para 0103, pg. 8; *concurrent c-spaces* - para 0131, pg. 8 -- – Note: activities of trading partners as C-space owner in defining roles and diagrams in a workflow model as in a browser-based modeling platform – see *browser*, para

0247, pg. 14 -- and configuring messages accordingly **read on** using plug-in modules inside the

graphical design tool to modifying the model or the messaging requirements, and browser-based

configuration further teaching integral browser plug-in for enabling as needed-basis runtime

modification/enhancement of browser layout).

As per claim 9, Stewart discloses wherein said platform domain comprises a platform for

a mobile terminal for a wireless telecommunications system (see para 0278, pg. 16).

As per claim 10, Stewart discloses a method for extending and/or modifying

functionality of a platform for a mobile terminal of a wireless telecommunications system,

comprising:

providing a mobile terminal platform domain having a software services component for

providing functionality, and

an interface component having at least one interface for providing access to the

functionality of the software services component for enabling application domain software to be

installed, loaded and run in said platform via said at least one interface;

providing plug-in software together with the application software for extending and/or

modifying the functionality of the software services component of the platform domain via the at

least one interface; and

extending and/or modifying the functionality of the software services component via said

plug-in software;

 all of which limitations having been addressed in claim 1.

As per claims 11-15, these claims include respectively the subject matter of claims 3-6,

and 8; hence incorporate the corresponding rejection as set forth therein.

As per claims 16-17, Stewart discloses enterprise wide collaboration among trading

partner or C-space owners (see para 0164, pg. 11 – Note: each user of such federated model is a

customer using the model process) having C-space instance for locally defining a workflow,

hence discloses a modeling paradigm wherein any client in the WebLogic network can

collaborate with a modeling step of extending and/or modifying the functionality is performed *by*

a customer of a provider of said platform (see Fig. 13-16; para 0172, pg. 11; 0237, pg. 13);

wherein said customer comprises an end user product manufacturer (*manufacturer* – para 0086,

pg. 7).

As per claim 18, Stewart discloses C-space being made available to variety of users for

extending and/or modifying the functionality, i.e. performed by a third party (e.g. para 0087, pg.

7) contracted to change the functionality.

As per claim 19, Stewart discloses adding or removing functionality to said software

services component of said platform (e.g. para 0171, 0174, 0183, pg. 11-12).

As per claim 20, refer to claim 9

As per claim 21, Stewart discloses step of modifying the functionality is performed by

downloading an application (para 0172, pg. 11; para 0182-0187, pg. 12 -- Note: data

communicated to trading partners for these to participate/collaborate in the C-hubs by way of

plug-ins or C-enabling lightweight downloadable software to instantly customize or modify the

hub/protocols communications or functionality – see para 0184-0189; *C-enabler* -- para 0239,

pg. 13 -- **reads on** downloading an application; and downloading of plug-ins).

As per claim 22, with respect to claim 10, Stewart discloses downloading at least one

plug-in (refer to claim 21 - Note: data communicated to trading partners for these to participate

in the C-hubs by way of plug-ins or C-enabling lightweight downloadable software to instantly

customize or modify the hub/protocols communications – see para 0184-0189; *C-enabler* -- para

0239, pg. 13--reads on downloading an application; and reads on downloading plug-ins)

Response to Arguments

8.   Applicant's arguments filed 12/07/06 have been fully considered but they are not

persuasive. Following are the Examiner's observation in regard thereto.

Double Patenting Rejection:

(A)   The Terminal Disclaimer submitted applies to the patent Application 10/359772;

however, the rejection address conflicting claim issues against copending Application

10,664,618; and for this a Double Patenting case of obviousness rejection is still outstanding.

35 USC §101 Rejection:

(B)   As set forth in the rejection, merely reciting a preamble with a intended purpose of

supporting a wireless platform without specific and explicit hardware support/inclusion in the

system for such platform (and the *domain component/plug-in* entities) to realize its functionality

is insufficient to convey or fulfill any realization of a tangible result. The claims still stand

rejected because of lack of tangible execution hardware embodiment to carry out software

functionality into statutory results.

35 USC §102(e) Rejection:

(C)   Applicants have submitted that Stewart although supports B2B infrastructure via

collaboration using pluggable hub components with participants message exchange, does not

disclose modifying functionality for a mobile terminal in a wireless communications (Appl.

Rmrks, pg. 7, middle para). In reply, it is noted that there is nothing particularly wireless-

oriented, nor is there any mobile-station implementation details in the claim language to make

this mobile platform limitation convincingly (emphasis added) distinguishing -- in terms of the

(services components) functionality modifying or extending as recited -- over what Stewart

discloses via user's obtaining of plug-in to modify and customize the collaboration-hub services,

protocol or functionality. Notwithstanding this, the mobile/wireless platform as claimed appears

to be a intended use for it is not supported in the claim with more specifics pertinent to this very

use, i.e. wireless platform or telecommunications aspect of it. Intended use without claim

specifics amounts to a non-patentable weight, and would be treated only in the extent of how the

claim as a whole conveys. That is, the recited software service components, interface component

for access and loading software, and plug-in(s) for extending the service components, amount to

what is claimed, thus are subject to interpretation as such, and prosecuted for merits only to the

extent thereof. Stewart's collaboration and pluggable lightweight downloadable software as set

forth in the rejection has mapped all of the above. The argument is therefore non-persuasive

because the claim does not provide sufficient teaching about how this wireless domain is

implemented to sufficiently overcome Stewart's teaching as applied; Applicant's arguments fail

to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims

define a patentable invention without specifically pointing out how the language of the claims

patentably distinguishes them from the references.

In view of the above, the claims 1-22 stand rejected as set forth in the Office Action.

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The examiner can

normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

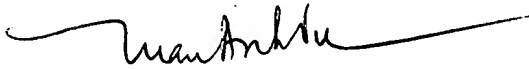supervisor, Meng-Ai An can be reached on (571)272-3756.

The fax phone number for the organization where this application or proceeding is

assigned is (571) 273-3735 (for non-official correspondence - please consult Examiner before

using) or 571-273-8300 (for official correspondence) or redirected to customer service at 571-

272-3609.

Any inquiry of a general nature or relating to the status of this application should be

directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan A Vu
Patent Examiner,
Art Unit 2193
February 22, 2007